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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/127,364 07/31/98 YEDNOCK

T 193-US-CIP2

021835 HM12/1115  
ELAN PHARMACEUTICALS, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
800 GATEWAY BOULEVARD  
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EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1653

10

DATE MAILED:

11/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
09/127,364

Applicant(s)

Yedn ck

Examiner

David Lukton

Group Art Unit  
1653



☒ Responsive to communication(s) filed on Aug 28, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-23 is/are pending in the application

Of the above, claim(s) 7, 8, and 11-23 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-6, 9, and 10 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Applicants' election of Group 1 with traverse is acknowledged, as is the elected specie. However, since the elected group encompasses compounds which are disclosed in other applications, a second restriction is imposed, as set forth below. First, however, the following abbreviations are used hereinbelow:

**G1:** This subgenus remains the same as previously defined (paper No. 7, mailed 4/18/00).

**G2:** This subgenus remains the same as previously defined (paper No. 7, mailed 4/18/00).

**G3:** This subgenus remains the same as previously defined (paper No. 7, mailed 4/18/00).

**G4:** This subgenus is limited to the compounds disclosed in application 08/904415.

**G5:** This subgenus is limited to the compounds disclosed in application 08/903585.

**G6:** This subgenus is limited to the compounds disclosed in application 08/904423.

**G7:** This subgenus is limited to the compounds disclosed in application 08/920353.

**G8:** This subgenus is limited to the compounds disclosed in application 08/904417.

**G9:** This subgenus is limited to the compounds disclosed in application 08/920394.

**G10:** This subgenus is limited to the compounds disclosed in application 08/904416.

**G11:** This subgenus encompasses any compound that is encompassed by claim 1, with the proviso that subgenus G1 is excluded, and with the further proviso that all compounds that are explicitly recited in application 09/127,364 are also excluded.

\*

Restriction to one of the following inventions is required under 35 U.S.C. §121 (the numbering of groups begins with "10" to avoid overlap with groups defined in the previous Office action):

10. Claims 1-6, 9, 10 drawn to compounds which are limited to G4.
11. Claims 1-6, 9, 10 drawn to compounds which are limited to G5.
12. Claims 1-6, 9, 10 drawn to compounds which are limited to G6.
13. Claims 1-6, 9, 10 drawn to compounds which are limited to G7.
14. Claims 1-6, 9, 10 drawn to compounds which are limited to G8.
15. Claims 1-6, 9, 10 drawn to compounds which are limited to G9.
16. Claims 1-6, 9, 10 drawn to compounds which are limited to G10.
17. Claims 1-6, 9, 10 drawn to compounds which are limited to G11.

The claimed inventions are presumed to be distinct.

Each of Groups 10-16 is drawn to compounds that are defined in a different application. It appears that the instant application is largely a vehicle for aggregating other patent applications. The initial assumption will be made that each application defines a patentably distinct genus. However, if further discussion about the distinction between compounds in each of groups 10-16 is sought, applicants are invited to provide a copy of

each of the following applications: 08/904415, 08/903585, 08/904423, 08/920353, 08/904417, 08/920394, and 08/904416.

In view of the revised restriction, applicants may elect a new specie, or reaffirm the one previously selected. However, if the elected specie does not fall within the scope of the elected invention, applicants' election will be viewed as non-responsive.

Applicants have traversed the first restriction by arguing that some of the compounds of G1 overlap some of the compounds of G2 and G3. In response, the examiner would argue that if, for example, applicants want to have the compounds of G2 examined, they can either elect Group G2, or else another Group which overlaps G2. Thus, applicants will be achieving their objectives in either case. Applicants have also implied that there is a prohibition against imposing a restriction between two groups if there is overlap between them. However, applicants have cited no authority which imposes such a bar. Moreover, if overlap of genera is a genuine concern, applicants may propose a further reduction in the scope of the elected genus. It is very likely that the examiner will comply with any request by applicants to reduce the scope of the elected invention. Moreover, in the event that claims are found allowable, and a divisional application filed, applicants need not feel bound to include any of the allowed compounds in the divisional application, so the point would appear to be moot.

Group 17 is included for the sake of completeness, but it seems unlikely that applicants will elect it. However, in the event that applicants do elect group 17, a new species

election will be required, since Group 17 excludes all compounds that are explicitly recited in the instant application, as well as the applications listed above. The issue of new matter will not arise as long as applicants do not attempt to claim the species in question.

The possibility of a third restriction is not precluded. After applicants have identified the actual application (apart from the "aggregation vehicle") that they would like to have examined, the matter of further restriction will be considered.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . . .

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

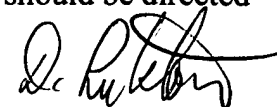
Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
**DAVID LUKTON**  
**PATENT EXAMINER**  
**GROUP 1800**